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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,613	09/26/2003	Gerd Dannhardt	104035.269169	3699

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EXAMINER

WALLER, ROBIN REGINA

ART UNIT PAPER NUMBER

1626

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/672,613

### Applicant(s)

DANNHARDT ET AL.

### Examiner

Robin R. Waller

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 2,4-8,11-19 and 21-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

Claims 1-23 are pending

### Information Disclosure Statement

Applicants Information Disclosure Statement, filed 09/10/04 has been considered.

### Priority

This application claims the benefit of PCT/EP02/03264 filed 03/22/2003.

### *Election/Restrictions*

The Markush group set forth in the claims includes both independent and distinct inventions, and patentable distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentable distinct inventions far too numerous to list individually. Moreover, each of these inventions contains a plurality of patentable distinct compounds, also far too numerous to list individually. **For these reasons provided below, restriction to one of the following Groups is required under 35 U.S.C. 121**, wherein a Group is a set of patentable distinct inventions of a broad statutory category (e.g. compounds, methods of use, methods of making, etc.):

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20 are drawn to compounds, compositions and cosmetics, classified in class 548/311.1, 424.

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- II. Claims 21-23 are drawn to method of treating, classified in class 514 and various subclasses.

In accordance with the decisions in *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984), restriction of a Markush group is proper where the compounds within the group either (1) do not share a common utility, or (2) do not share a substantial structural feature disclosed as being essential to that utility. In addition, a Markush group may encompass a plurality of independent and distinct inventions where two or more members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the other member(s) obvious under 35 U.S.C. 103.

**Where an election of any one of Groups I-II is made, an election of a single compound is further required** including an exact definition of each substitution on the base molecule (Formula (I)), wherein a single member at each substituent group or moiety is selected. For example, if a base molecule has a substituent group R1, wherein R1 is recited to be any one of H, OH, COOH, aryl, alkoxy, halogen, amino, etc., then applicant must select a single substituent f R1, for example OH or aryl and each subsequent variable position. In the instant case, upon election of a single compound, the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention will encompass all compounds within the scope

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of the claim, which fall into the same class and subclass as the elected compound, but may also include additional compounds, which fall in related subclasses. Examination will then proceed on the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification. A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits. Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of compounds along with (if appropriate) the process of using or making said compound under examination. This will be set forth by reference to specific class(es) and subclass(es) examined. Should applicant traverse on the ground that the compound are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the compound to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other.

All compounds falling outside the class(es) and subclass(es) of the selected compound and any other subclass encompassed by the election above will be directed to nonelected subject matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R. 1.142(b). Applicant may reserve the right to file divisional applications on the remaining subject matter. (The provisions of 35 U.S.C. 121 apply with regard to double patenting covering divisional applications.)

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Applicant is reminded that upon cancellation of claims to a nonelected invention, the inventions must be amended in compliance with 37 C.F.R. 1.48(b) if one of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(i).

Markush claims must be provided with support in the disclosure for each member of the Markush group. See MPEP 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the base molecule to be consistent with the written description.

### **Rationale Establishing Patentable Distinctiveness Within Each Group**

Each Group listed above is directed to or involves the use of compounds which are recognized in the art as being distinct from one another because of their diverse chemical structure, their different chemical properties, modes of action, different effects and reactive conditions (MPEP 806.04, MPEP 808.01). Additionally, the level of skill in the art is not such that one invention would be obvious over the other invention (Group), i.e. they are patentable over each other. Chemical structures, which are similar, are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly. The presumption even for similar chemical structures though is not irrebuttable, but may be overcome by scientific reasoning or evidence showing that the structure of the prior art would not have been expected to function as the structure of the claimed invention. Note that in accordance with the holding of

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Application of Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and In re Lalu, 223 USPQ 1257 (Fed. Cir. 1984), chemical structures are patentably distinct where the structures are either not structurally similar, or the prior art fails to suggest a function of a claimed compound would have been expected from a similar structure.

***The above groups represent general areas wherein the invention are independent and distinct, each from the other because of the following***

***reasons:***

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the compounds and compositions in Group I can be used for the treatment Alzheimer's, colon cancer and inhibition of commencing labor .

Since different search considerations are involved for each of the Groups, it would be a burden to the Examiner and the Patent Office's resources if the instant application was unrestricted.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

***Advisory of Rejoinder***

The following is a recitation of M.P.E.P. 821.04, Rejoinder:

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Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121. In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance. Amendments submitted after final rejection are governed by 37 CFR 1.116. Process claims which do not depend from or otherwise include the limitations of the patentable product will be withdrawn from consideration, via an election by original presentation (see MPEP § 821.03). Amendments submitted after allowance are governed by 37 CFR 1.312. Process claims which depend from or otherwise include all the limitations of an allowed product claim and which meet the requirements of 35 U.S.C. 101, 102, 103, and 112 may be entered.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR 1.129(b), applicant may either: (A) elect the invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and examined under 37 CFR 1.129(b)(2); or (B) elect the invention to be searched and examined and not pay the additional fee (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined. If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129(b)(2) even if the product is found allowable, applicant would not be entitled to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26(a) states that "[T]he Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee...will not entitle a party to a refund of such fee..." In this case, the fees paid under 37 CFR 1.129(b) were not paid by mistake nor paid in excess, therefore, applicant would not be entitled to a refund. In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action. Form paragraphs 8.42 through 8.44 should be used to notify applicant of the rejoinder of process claims which depend from or otherwise include all the limitations of an allowable product claim.

In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104 - 1.106. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.



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The following is a recitation from paragraph five, "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. §103(b)" (1184 TMOG 86(March 26, 1996)):

"However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim **depends from or otherwise includes all the limitations of** an allowed product claim. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined." (emphasis added)

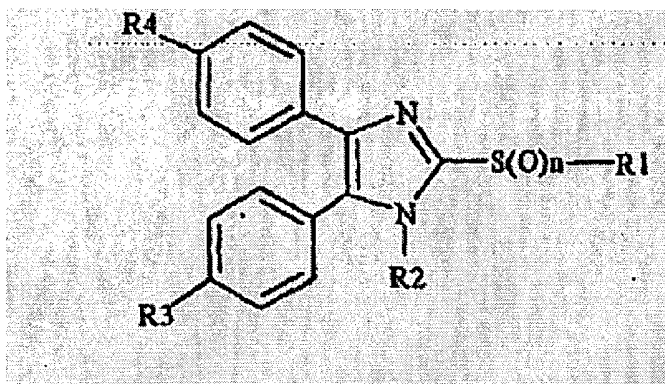
Therefore, in accordance with M.P.EP 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

A telephone call was made to Ms. Meunier on 09/15/04 to request an oral election to the above restriction requirement. As a result, Applicant elects Group I, which are Claims 1-20 and the Applicant further elects the compound in example 140. (See Specification page 29, line 1).

The restriction requirement states upon the election of a single compound, the office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound and examination will then proceed on the elected compound and the entire scope of the invention encompassing the elected compound as defined by common classification.

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Therefore, as stated by the restriction requirement, the elected invention for search and examination is products of Formula 1:



The compounds described in claims 1-6 partial subject matter of 8 and 16, 9-15,18 wherein CON R5R6, in which R5 and R6 independently of one another are H or C1-C6-alkyl or ACONR5 and R6, in which a is C1-C6-alkylene which is optionally substituted by C1-C3-alkyl-CO, and R5 and R6 independently of one another are H1 C1-C6-alkyl or phenyl which is optionally substituted by one or 2 halogen atoms; C1-C6-alkylene-R7, where is VR5R6, or COOR8, R5 and R6 independently of one another are H or C1-C6-alkyl and R8 is H or C1-C6-alkyl; C1-C6-alkylene- CO-R9, where R9 is Phenyl which is optionally substituted by halogen, C1-C6-alkylene- NR10-CO-R11 or C1-C6-alkylene- NR10-SO2-R12, R10is H or C1-C6-alkyl, R11is phenyl which is optionally substituted by 1,2 or 3 substituents, which independently of one another are selected from halogen, CN, No2, CF3, OC1-C6-alkyl and C1-C6-alkyl, naphthyl, C1-C6-alkyl which is optionally substituted by 1 or 2 phenyl groups, C2-C6-alkenyl, NR5R6, where R5 and R6 independently of one another are H or C1-C6-alkyl; R12 is phenyl which optionally has 1,2,or 3 substituents which independently of one another are

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selected from halogen,  $\text{NO}_2$ ,  $\text{F}$ ,  $\text{OC1-C6-alkyl}$ ,  $\text{C1-C6-alkyl}$ ,  $\text{NH}_2$  and  $\text{NHCOC1-C3-alkyl}$ ,  $\text{C1-C6-alkyl}$  which is optionally substituted by one or two phenyl groups or naphthyl,  $\text{R}_2$  is  $\text{H}$ ,  $\text{C1-C6-alkyl}$  or  $(\text{CH}_2)_o\text{COOH}$ ;  $\text{R}_3$  and  $\text{R}_4$ , which can be identical or different, are  $\text{H}$ ,  $\text{OH}$ ,  $\text{OC1-C6-alkyl}$ , halogen or  $\text{C1-C6-alkyl}$  which is substituted by 1, 2 or 3 halogen atoms, where at least one of the radicals  $\text{R}_3$  and  $\text{R}_4$  is  $\text{OH}$  or  $\text{OC1-C6-alkyl}$ ,  $n$  is 0, 1 or 2 and  $o$  is  $-0, 1, 2, 3$  or 4 and the optical isomer and physiologically tolerable salts thereof.

The remaining subject matter of claims 1, 3, 9, 10 and 20 and the subject matter of 2, 4-8, 11-19 and 21-23 that are not drawn to the above elected invention under 37 CFR 1.142(b) as being non-elected subject matter of claims. The remaining compounds which are not within the elected invention, which are independent and distinct from the elected invention and do not have unity with the elected compound and therefore withdrawn by means of restriction requirement within the claims are for example in which  $\text{CON R}_5\text{R}_6$ , in which  $\text{R}_5$  and  $\text{R}_6$  together with the nitrogen atom to which they are bonded, form a saturated heterocyclic radical having 5 or 6 ring atoms and one or two heteroatoms which independently of one another are selected from  $\text{N}$  or  $\text{O}$ ;  $\text{C1-C6-alkylene- R}_7$ , where  $\text{R}_7$  is  $\text{NR}_5\text{R}_6$ , an aromatic heterocyclic radical having 5 or 6 ring atoms and one or two heteroatoms, which independently of one another are selected from  $\text{N}$ ,  $\text{S}$  and  $\text{O}$  where the heterocyclic radical can optionally be fused to a benzene ring or  $\text{R}_{11}$  is an aromatic, heterocyclic radical having 5 or 6 ring atoms and 1 or 2 heteroatoms, which independently of one another are  $\text{H}$  or  $\text{C1-C6-alkyl}$ .

The above mentioned withdrawn compounds which are withdrawn from consideration as being for nonelected subject matter that differ materially in structure

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and composition from the compounds of the elected invention. The withdrawn compounds which differ from those of the elected invention, such as pyridine 546, subclass 100+ furanyl, class 549 subclass (1)+ thienyl, class 548 subclasss (300.1) which are chemically recognized to differ in structure and function. This recognized chemical diversity of the compounds can be seen by the various classification of these compounds in the U.S. classification system, i.e. pyridine class 546 subclass 100+, furanyl, class 549 subclass (1)+ thienyl, class 548 subclasss (300.1) etc, . Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition and have been restricted properly as a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter.

These withdrawn compounds are independent and distinct from the elected invention and do not have unity with the species elected and are therefore withdrawn by means of a restriction requirement within the claims.

The requirement is still deemed proper.

### ***Claim Objections***

The closet prior art of record is **Wilde US 5,364,875** which discloses compound #52 which differs from the elected invention by substituent R1. The prior art reference neither teaches nor provides motivation to prepare the Applicant's instantly claimed elected invention

Claims 2,4-8,11-19 and 21-23 and the remaining subject matter of claims 1,3,9,10 and 20 are objected to as containing non-elected subject matter but

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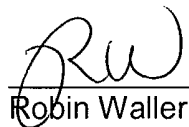
would appear allowable over the prior art of record, if rewritten to include only the elected invention as identified supra and free of the following rejections.

### Conclusion

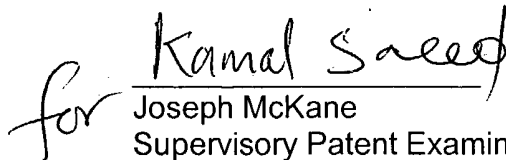
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Robin R. Waller whose telephone number is (571) 272-0696. Mrs. Waller can normally be reached Monday through Friday 8:30AM to 5:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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